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Patent
Attorney's Docket No. 003300-798

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Peter ERICKSSON *et al.*) Group Art Unit: 1632
Application No.: 09/889,242) Examiner: Liping Chen
Filed: July 13, 2001) Confirmation No.: 9923
For: METHOD FOR INTRODUCING)
SUBSTANCES INTO CELLS, AND)
USE OF SAID METHOD)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Response to Restriction Requirement is in complete response to the Official Action (Restriction Requirement) mailed on December 27, 2002 (Paper No. 6). A four-month Extension of Time is included, extending the time period of response to May 27, 2003. Applicants hereby elect with traverse the claims of **Group I** (Claims 1-4, 7-14, and 23), which are drawn to a method for introducing a substance comprising a nucleic acid into a mammalian neural term cell or progenitor cell *in vitro*, wherein the substance comprises a single or double stranded, linear or circular DNA.

Unity of invention is fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

37 C.F.R. § 1.475. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. *Id.*

Applicants submit that the present claims are directed to the same technical feature, as they all are directed to methods of introducing substances into mammalian stem cells or progenitor cells. For example, Groups I, II and III are drawn to a method for introducing a substance comprising a nucleic acid into a mammalian neural term cell or progenitor cell *in vitro*. Groups IX, X and XI are drawn to a method for introducing a substance comprising a nucleic acid into a mammalian neural term cell or progenitor cell *in vivo*. Thus, Applicants request that all sixteen groups be rejoined. A complete search for all groups of claims would be coextensive such that search and examination of the entire application can be made without serious burden on the U.S. Patent and Trademark Office.

As Applicants have elected Group I, the Examiner requires that one type of protein be chosen. For purposes of examination, Applicants elect fluorescent proteins, with traverse. Applicants note that all of the claims of Group I are directed to DNA that express a marker which can be used for selection of different types of cells resulting from the stem cells or progenitor cells (For example as recited in claim 9). The type of marker is not important for the actual invention, so long as some signal is produced allowing detection. Thus, Applicants submit that search and examination of the entirety of elected Group I can be made without serious burden.

As Applicants have traversed the rejection, Applicants note for the record the following regarding the instant restriction requirement. Under M.P.E.P. § 803, a restriction is proper if the subject matter can be restricted into one of two or more claimed inventions, and these inventions are either independent (M.P.E.P. § 806.04) or distinct (M.P.E.P. § 806.05). However, the second element for a restriction requirement to be proper is that if the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent and distinct inventions. Accordingly, Applicants assert that a proper restriction under M.P.E.P. § 803 has not been set forth with regard to the originally presented claims. The restriction should be withdrawn or, at the very least, reconsidered.

C O N C L U S I O N

Applicants submit that the present application is fully in condition for examination.

An early examination on the merits is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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Date: May 27, 2003

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